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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/603,471  | 06/25/2003  | Larry Gause            | MSDI-259/PC/757.00  | 3218             |
| 52196 7590 06/11/2008<br>KRIEG DEVAULT LLP<br>ONE INDIANA SQUARE, SUITE 2800<br>INDIANAPOLIS, IN 46204-2709 |             |                        |                     |                  |
| EXAMINER<br>RAMANA, ANURADHA  |             |                        |                     |                  |
| ART UNIT<br>3733  |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>06/11/2008   |             | DELIVERY MODE<br>PAPER |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/603,471

**Applicant(s)**

GAUSE ET AL.

**Examiner**

Anu Ramana

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,11-38,59-62,81,82,87 and 89-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,11-38,59-62,81,82,87 and 89-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2008 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates et al. (US 5,423,826).

Coates et al. disclose a plating system including: a plate 22 with two bone fastener holes; a holding instrument including actuating system having a movable linkage member 152 and a stationary linkage member 151; first and second holding members 157 coupled to the stationary and linkage members, respectively, wherein the holding members are movable along the longitudinal axis due to the presence of the hinge connections (164, 165); and a guide mechanism including a guide member 180 spaced proximally from the plate when the holding system is engaged with the plate and a laterally extending alignment member 159 (Figs. 10, 14, 17 and 19, col. 10, lines 36-68, col. 11, lines 1-48, col. 12, lines 67-68 and col. 13).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 11-14, 18, 20-27, 81-82, 87, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haider (US 2003/0105462 A1).

Haider discloses an elongate bone plate including an opening or "a visualization opening" having an hourglass shape with convexly and concavely curved side walls (Fig. 2 and paras [0027]-[0034]).

Haider discloses all elements of the claimed invention except for the claimed widths and length-to-width ratios.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a visualization opening with the claimed length-to-width ratios, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 1, 4, 11-15, 18-27, 81-82, 87, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 6,413,259).

Lyons et al. disclose a bone plate 12 including a visualization openings 28; first and second anchors 22 on each side of the visualization openings; and retaining devices 22 to prevent the bone anchors from backing out of the plate (Figs. 1-3, col. 4, lines 43-67, cols. 5-6 and col. 7, lines 1-36).

Lyons et al. disclose all elements of the claimed invention except for: (1) an hour-glass shape of the visualization opening; (2) the curvatures of the side walls of the

visualization opening; and (3) the widths and length-to-width ratios of the visualization opening.

It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to have provided the visualization opening with the claimed shapes of the walls, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing a visualization opening. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

It would have also been obvious to one having ordinary skill in the art at the time the invention was made to have provided a visualization opening with the claimed length-to-width ratios, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 16-17, 28-35 and 89-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 6,413,259) in view of Michelson (US 6,193,721).

Lyons et al. disclose all elements of the claimed invention except for: (1) a holding instrument to hold the plate; and (2) the claimed shape of the visualization opening.

Michelson teaches a type of plate holder to hold a plate in position wherein the plate holder has an actuating system; first and second holding members wherein one is holding member is stationary and the other is movable to selectively engage the plate; and a guide mechanism including a guide member 54 positioned relative to the plate (Figs. 38 and 39, col. 20, lines 48-53, col. 21, lines 56-67 and col. 22, lines 1-51). It is noted that the proximal portion of movable arm 130 constitutes a linkage

It would have been obvious to one of ordinary skill in the art to have utilized a plate holder as taught by Michelson to hold the Lyons et al. plate since it was well known in the art to use a plate holder to position a plate against bone.

Claims 1, 4, 11-15, 18, 20-27, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bono et al. (US 5,954,722).

Bono et al. disclose an elongate bone plate 50 with a visualization opening 59 (col.3, lines 48-67, cols. 4-6 and col. 7, lines 1-49).

Bono et al. disclose all elements of the claimed invention except for: (1) the visualization opening having an hourglass shape; (2) concave/convex curvatures of the visualization opening walls; and (3) the claimed widths and the length-to-width ratios.

It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to have provided the visualization opening with the claimed shapes of the walls, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing visualization opening. *In re Dailey and Eilers, 149 USPQ 47 (1966).*

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a visualization opening with the claimed length-to-width ratios, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller, 105 USPQ 233.*

Claims 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bono et al. (US 5,954,722) in view of Boucher et al. (US 6,514,274).

Bono et al. disclose all elements of the claimed invention except for the plate being made of a material that is translucent.

Boucher et al. teach making a plate of a translucent material to enable visual alignment of the plate with holes in the underlying bone (col. 4, lines 14-30).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the Bono et al. plate of a translucent,

material as taught by Boucher et al., to enable visual alignment of the plate with underlying bone holes.

Claims 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Lyons et al. (US 6,413,259) view of Boucher et al. (US 6,514,274).

Lyons et al. disclose all elements of the claimed invention except for the plate being made of a material that is translucent.

Boucher et al. teach making a plate of a translucent material to enable visual alignment of the plate with holes in the underlying bone (col. 4, lines 14-30).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the Lyons et al. plate of a resorbable, translucent, material as taught by Boucher et al., to enable visual alignment of the plate with underlying bone holes.

### ***Response to Arguments***

Applicants' arguments submitted under "REMARKS" in the response filed on February 28, 2008 have been fully considered.

Regarding the rejections of claims 36-38 under 35 USC 102(b) as being anticipated by Coates et al. (US 5,423,826), contrary to Applicants' arguments, Coates et al. clearly disclose guide member 180 mounted to the stationary member and spaced proximally from the plate (Fig. 19).

Applicants' arguments with respect to the various rejections under 35 USC 103(a) over Lyons et al., the Examiner reiterates that Applicants' disclosure as originally filed states that the visualization openings 60 can take other shapes and sizes (page 12, lines 22-23). It is the examiner's position that the claimed features are rendered obvious when a person of ordinary skill in the art changes the size and/or shape of visualization opening 28.

Regarding Applicants' arguments with respect to the rejections of 59-62 under 35 USC 103(a) over Bono et al. in view of Boucher et al., the Examiner notes that Bono clearly discloses a visualization opening 59. It is the Examiner's position that the claimed features are rendered obvious when a person of ordinary skill in the art changes the size and/or shape of visualization opening 59. Contrary to Applicant's arguments that Bono et al. do not disclose a uniform width along the oval hole, the Examiner notes that Bono et al. "include a uniform width along the visualization opening" to the same extent as Applicant does (compare Fig. 2 of Bono et al. with Applicant's "uniform width" as shown in Fig. 3 of Applicant's disclosure).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

June 8, 2008

/Anu Ramana/  
Primary Examiner, Art Unit 3733